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09/750,307	12/29/2000	Robert G. Ballen	56468.000003	6733

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EXAMINER
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VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/750,307

Applicant(s)

BALLEN ET AL. *CB*

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Specification***

The abstract of the disclosure is objected to because on page 20, line 2 the word "companies" is misspelled. Examiner reads "companies" as "companies". Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

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promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 – 36 only recites an abstract idea. The recited steps of merely obtaining obtaining identification information of a plurality of subscribers, obtaining a list of organizations from each individual subscriber to which privacy instructions are to be communicated on behalf of the individual subscriber, aggregating a list of subscribers, communicating a request to particular organization on behalf of those on the list of subscribers and maintaining database(s) does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how communicate privacy instructions of first part to second party.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, a computer system apparatus for protecting subscriber privacy programmed with software for maintaining a database of information, and routines to obtain identification information from the plurality of subscribers, obtain an indication of which organizations each individual subscriber desires to protect their personal information, generate

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communications to organizations on behalf of a plurality of subscribers and communicating responses from organizations to subscribers, it is not clear whether the application is an commercially available application for providing communication between the first and second party (for example, a mail server). Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps of the claimed invention. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention performs communication between first party and second party (i.e., repeatable) used in communicating a request to honor the privacy instructions of the first party (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1 – 32 are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson US Patent 6,609,106.

Regarding claim 1, Robertson teaches system and method for protecting consumer privacy (protecting consumer privacy is the product provided by the applicant, and, gift registry is the product provided by Robertson) [col. 1, lines 44 – 49]. Applicant provides service for privacy protection between subscriber and company [application Fig. 3, 4, 5], whereas, Robertson provides service for gift registration between gift recipient, purchasers and merchants [Fig. 1]. Both applicant and Robertson function as a middleman between clients and service providers. Robertson teaches:

obtaining identification information of a plurality of subscribers (consumers to register with Robertson system and method) [col. 9, line 7];

obtaining a list of organizations from each individual subscriber of the plurality of subscribers, each list of organizations designating organizations to which privacy instructions are to be communicated on behalf of the individual subscriber (wish list or items of interest which may be provided by plurality of vendors) [col. 9, line 7];

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aggregating a list of subscribers wishing to communicate the privacy instructions to a particular organization [purchasers purchasing gift for registrant [col. 2, lines 14 – 26]; and

Robertson does not teach communicating a request to honor the privacy instructions (communicating privacy instructions is the product sold by the applicant, i.e. fulfilling purchasers requirements) to the particular organization on behalf of those on the list of subscribers. However, Robertson teaches to communicate purchased gift items (request to fulfill purchasers requirements) to particular merchant (particular organization) on behalf of gift recipient and gift purchaser.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robertson and use it for providing other services (field of use) to fulfill customer requirements. For example, online shopping for business to consumer modified for online shopping for consumer to consumer (e.g. eBay) and business to business.

Regarding claim 2, Robertson teaches obtaining identification information and obtaining a list of organizations include soliciting subscriber input over the internet (Robertson provides access over the internet) [col. 1, lines 50 – 55].

Regarding claim 3, Robertson teaches obtaining identification information and obtaining a list of organizations include subscriber interaction with a web page [Fig. 15].

Regarding claim 4, Robertson teaches aggregating includes aggregating a list of subscribers wishing to communicate privacy instructions for each of a plurality of organizations (Robertson teaches aggregation of information for later sending) [Fig. 7, 204].

Regarding claim 5, Robertson teaches obtaining a list of organizations includes providing each of the plurality of subscribers with a list of organizations from which to select (customer registers gifts which may be supplied by plurality of merchants) [col. 2, lines 14 – 25].

Regarding claim 6, Robertson teaches communicating to each subscriber on the list of subscribers how the particular organization responded to the step of communicating a request to honor privacy instructions (email notification) [claim 9].



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Regarding claim 7, Robertson teaches communicating with the particular organization a second time when no response is received to the step of communicating a request to honor privacy instructions (teachings of sending reminders) [Fig. 5].

Regarding claim 8, Robertson teaches allowing each of the plurality of subscribers to change their identification information (profile maintenance) [Fig. 22].

Regarding claim 9, Robertson teaches providing each of the plurality of subscribers with access to information regarding status of the request to honor privacy instructions (order confirmation) [Fig. 14, Fig. 41].

Regarding claim 10, Robertson teaches providing each of the plurality of subscribers with information regarding status of privacy instructions on each organization on the list of organizations obtained from that subscriber (applicant's product is privacy instructions whereas Robertson product is gift item [Fig. 41, # of items received]).

Regarding claim 11, Robertson teaches providing each individual subscriber the option to vary the privacy instructions (wish list maintenance) [Fig. 21].

Regarding claim 12, Roberson teaches accepting a plurality of potential subscribers as subscribers (distribution list) [Fig. 27].

Regarding claim 13, Robertson teaches receiving payment from each of the plurality of potential subscribers (teaches capability to accept payments) [Fig. 36].

Regarding claim 14, Robertson teaches communicating privacy instructions (gift item) to the particular organization on behalf of those on the list of subscribers periodically (aggregates information for later transmission) [Fig. 7].

Regarding claim 15, Robertson does not teach:  
soliciting renewal payment from each of the plurality of subscribers periodically.  
However, Robertson teaches reminder and solicitation functionality [col. 14, line 53].  
Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that if the business decides to charge subscription

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fee for providing services, then, it is obvious that the business solicit users for renewal fee to limit access of the system to paid clients only. For example, cable service providers send monthly bills, magazine subscriptions, prepaid legal services etc.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robertson reminder and notification functionality for soliciting renewal payment to remind user that the subscription fee is due, and, user needs to be pay subscription fee to continue receiving services.

ceasing to include those subscriber who fail to provide renewal payment on the list of subscribers. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that when a client who fail to provide renewal payment (do not renew service agreement) are ceased (blocked) to user the system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to cease clients who fail to provide renewal payment to limit the access of the system to paid clients only.

Regarding claim 16, Robertson teaches system and method for protecting consumer privacy (protecting consumer privacy is the product provided by the applicant, and, gift registry is the product provided by Robertson) [col. 1, lines 44 – 49]. Applicant provides service for privacy protection between subscriber and company [application Fig. 3, 4, 5], whereas, Robertson provides service for gift registration between gift recipient, purchasers and merchants [Fig. 1]. Both applicant and Robertson function as a middleman between clients and service providers. Robertson teaches:

obtaining from each individual subscriber of a plurality of subscribers (gift recipients) a list of organizations to which the individual subscriber requests instructions to be communicated (list of gifts they would like to receive, i.e. wish list); and

maintaining a database relating each individual subscriber (wish list) and organizations (merchants) to which each individual subscriber has requested that instructions be communicated (items purchased).

Robertson does not teach the instructions registering limits on use of information regarding the individual subscriber. However Robertson teaches instructing the instructing guests / gift purchasers what gifts the recipient would like for the occasion they have subscribed to the Robertson gift registry services (the instructions registering limits on use of information regarding the individual subscriber).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robertson and use it for providing other services (field of use) to customers. For example, Robertson instructs organizations how the user wishes its information to be used, and, Robertson teaches to instruct gift

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purchasers what gifts would a recipient like to receive. In both invention, the middleman is instructing the desires of the first party to the second party.

Regarding claim 17, Robertson teaches:

generating a communication to a selected organization (merchants) on behalf of a set of the plurality of subscribers (recipients, purchasers) who requested the instructions (items purchased) be communicated to the selected organization (merchant), the communication including the instructions registering limits on use of information regarding each subscriber of the set of the plurality of subscribers (quantity of items purchased, e.g. recipient wants 6 plates whereas the purchaser buys 2 plates); and

maintaining information in the database (wish list) relating each subscriber (recipient) and organizations (merchant) to which instructions have been communicated on behalf of the subscriber [Fig. 1].

Regarding claim 18, Robertson teaches:

obtaining from each individual subscriber (recipient, purchaser) an indication of specific requests to be included in the instructions (item purchased) registering limits on use of information regarding the individual subscriber (items desired by the recipient); and

maintaining information in the database relating each subscriber, organization, and the specific requests (gift purchase database) [Fig. 1].

Regarding claim 19, Robertson teaches repeating the step of generating a communication with respect to each organization (merchant) in the database as required (gift items purchase from plurality of merchants) [col. 9, line 8].

Regarding claim 20, Robertson teaches:  
obtaining from each of the plurality of subscriber identification data [Fig. 15]; and  
maintaining information in the database relating each subscriber and  
identification data (user database) [Fig. 1].

Regarding claim 21, Robertson teaches identification data is included in the communication to allow the selected organization to identify each subscriber (recipient, purchaser) in the set of the plurality of subscribers (recipient, purchaser) who requested instructions be communicated to the selected organization (items purchased from merchant) [Fig. 36].

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Regarding claim 22, Robertson teaches allowing subscribers to change the identification data maintained in the database that related to themselves (profile maintenance) [Fig. 22].

Regarding claim 23, Robertson teaches identification data including postal addresses, email addresses, and telephone numbers of subscribers [Fig. 16].

Regarding claim 24, Robertson does not teach identification data including social security numbers of subscribers. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to elect what data to use for identification services. For example, IRS uses Social Security Numbers to identify individual tax payers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Social Security Numbers of subscribers for identification to ensure that the number is unique number issued by a government agency ,and, use this number to track the subscriber when the subscriber cannot be located.

Regarding claim 25, Robertson teaches sending to a subscriber communications indicating organizations to which communications have recently been sent on behalf of the subscriber [col. 15, lines 15 – 18].

Regarding claim 26, Robertson teaches maintaining in the database information regarding a response of the selected organization to the communication (gift purchase database) [Fig. 1].

Regarding claim 27, Robertson does not teach generating a second communication to the selected organization in the event that the selected organization fails to respond to the original communication and in the event that the selected organization refuses to honor the instructions (send a reminder to the merchant to remind them to respond, i.e. reminder functionality). However, Robertson teaches reminder and solicitation functionality [col. 14, line 53]. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that when a response has not be received to an earlier request, user may send a reminder messages to ensure that the recipient of the message has received the message prior to take an alternate action.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send a reminder message to ensure that the user has



received the message to respond to prior to taking an alternate action to prevent misunderstandings in the transaction.

Robertson teaches maintaining information in the database regarding the organizations for which a second communication is generated (reminder database) [Fig. 1].

Regarding claim 28, Robertson does not teach relaying each response received from an organization to the instructions to each subscriber addressed in the response. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to send a message to subscriber every time there is an action taken, or allow them to check the status of their requested services.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robertson and relaying each response received from an organization to the instructions to each subscriber addressed in the response to provide up to date status to subscribers.

Regarding claim 29, Robertson does not teach relaying includes sending a communication to a subscriber that includes an indication that the organization will honor the instructions in the event the organization indicates it will honor the instructions

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with respect to the subscriber, information regarding the refusal of the organization to honor the instructions in the event the organization indicates it will not honor the instructions with respect to the subscriber and suggestions to the subscriber regarding additional action that may be taken. Sending communication to subscriber (message to subscriber) is answered earlier in response to claim 28, content of the message is a design choice. Robertson teaches providing alternate course of action which can be taken by the subscriber (i.e. suggestion) [Fig. 34].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robertson and send communication with responses received and suggestions to subscriber to inform subscriber of current status and provide guidance to subscriber to take an alternate action.

Regarding claim 30, Robertson teaches providing a subscriber information in the database regarding that subscriber [Fig. 7].

Regarding claim 31, Robertson teaches maintaining the renewal information in the database (user database) [Fig. 1].

Robertson does not teach obtaining renewal information periodically from each subscriber. Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that if the business decides to charge

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subscription fee for providing services, then, it is obvious that the business solicit users for renewal fee and obtain renewal information from subscribers to limit access of the system to paid clients only. For example, cable service providers send monthly bills, magazine subscriptions, prepaid legal services etc.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robertson and charge subscribers fee to use services, and obtain renewal information from subscribers to maintain user base and generate funds to keep the system functioning.

Regarding claim 32, Robertson teaches:

generating a communication to a selected organization (merchant) in which instructions regarding limits on use of information is sent on behalf of a set of the plurality of subscribers who requested instructions (items purchased by purchaser or subscriber) be communicated to the selected organization (merchant) after obtaining renewal information (i.e. user is an active user). Obtaining renewal information has been responded to earlier in response to claim 31; and

maintaining information in the database relating each subscriber and organizations to which instructions have been communicated on behalf of the subscriber (gift purchase database) [Fig. 1].

Regarding claim 33, Robertson teaches system and method for protecting consumer privacy (protecting consumer privacy is the product provided by the applicant, and, gift registry is the product provided by Robertson) [col. 1, lines 44 – 49]. Applicant provides service for privacy protection between subscriber and company [application Fig. 3, 4, 5], whereas, Robertson provides service for gift registration between gift recipient, purchasers and merchants [Fig. 1]. Both applicant and Robertson function as a middleman between clients and service providers. Robertson teaches a computer system apparatus (gift registry site) for protecting subscriber privacy (wish list) comprising a computer programmed with software for maintaining a database of information, the database relating individual subscribers of a plurality of subscribers (user database) and organizations (merchants) which the individual subscribers desire to protect personal information (acquire product). Robertson teaches:

a routine enabling the computer to obtain identification information from the plurality of subscribers (log on) [Fig. 15];

a routine enabling the computer to obtain an indication of which organizations each individual subscriber desires to protect their personal information (preferred reseller) [Fig. 33]; and

Robertson does not teach a routine enabling the computer to generate communications to organizations including instructions to protect personal information on behalf of a plurality of subscribers. However, Robertson teaches enabling the computer to generate communications to organizations (merchants) including instructions to what items have been purchased (protect personal information on behalf

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of a plurality of subscribers, i.e. product supported by applicant). [Fig. 7, send purchase information].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robertson and use it for providing other services (field of use) to customers. For example, online shopping for business to consumer modified for online shopping for consumer to consumer (e.g. eBay) and business to business.

Regarding claim 34, Robertson teaches a routine enabling the computer to retain and provide access to information regarding which organizations communications have been generated on behalf of each individual subscriber (store gift purchase for sending it at later time, and, items may be provided from plurality of merchants) [Fig. 6, col. 9, line 8].

Regarding claim 35, Robertson teaches a routine enabling the computer to accept and record in the database data regarding a response by an organization to the generated communication (gift purchase database) [Fig. 1].

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Regarding claim 36, Robertson teaches routine enabling the computer to obtain identification information (log on) [Fig. 15] and the routine enabling the computer to obtain an indication of which organizations each individual subscriber desires to protect their personal information [Fig. 33] each generate a web page through which subscribers interact with the computer system [Fig. 33].

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Cheng et al. US Patent 6,542,943

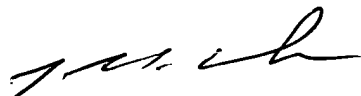
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig  
June 9, 2004



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